

U.S. Serial No. 10/604,829

REMARKS

In response to the Examiner's Reasons for Allowance, Applicant believes that a separate Statement of Reasons for Allowance is unnecessary in the present case as the file history sufficiently sets forth the patentable distinctions of claims 1-8 and 11-26.

In the statement of Reasons for Allowance the Examiner stated that the "prior art of record does not fairly teach or suggest applying only one non-selective inversion pulse followed by only one selective inversion pulse over the duration of a single R-R interval, as is presently claimed and described in the instant disclosure." *Notice of Allowability*, 04/08/2008, pg. 2. However, none of the claims call for applying only one non-selective inversion pulse followed by only one selective inversion pulse over the duration of a single R-R interval as asserted by the Examiner.

In response to Applicant filing a Declaration under 37 C.F.R. §1.131 to antedate the Fayad reference, the Examiner stated that the Declaration "is not permissible in instances where the reference US patent or patent publication claims the same subject matter claimed in the instant application." *Advisory Action*, 01/25/2008, p. 3. In response, Applicant explained that, for the purpose of entry of the Declaration under 1.131 that the claims of the present application and that of Fayad are not to the same invention and stated:

MPEP §715(ii)(B) states that a 37 CFR 1.131 declaration is inappropriate "[w]here the reference U.S. patent or U.S. patent application publication claims the same patentable invention." However, as stated in MPEP §715.05, "[a] 37 CFR 1.131 affidavit is ineffective to overcome a United States patent or patent application publication, not only where there is a verbatim correspondence between claims of the application and of the patent, but also where there is no patentable distinction between the respective claims."

Here, there does appear to be patentable distinctions. That is, the reference claims specifically require that administering a series of DIR preparation pulse modules at a repetition interval that is short enough that at least two DIR preparation pulse modules occur within each RR interval. This is more narrow than the presently pending claims that merely require the application of a non-selective inversion pulse in successive R-R intervals, and applying a re-inversion pulse in the successive R-R intervals that is slice-selective over a region encompassing a plurality of slice selections. This does NOT

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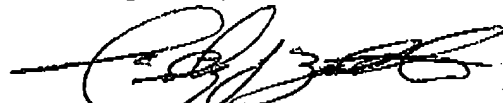
require "only" one, as the Examiner infers. A product or process made under the reference claims therefore may read on the present claims since the present claims are broader, but the claims may still be distinct in that the reference claims are more narrow.

It must be pointed out that Applicant did not argue patentability over Fayad, but merely argued that the claims are not the same for purposes of entry of the Declaration under 1.131 wherein the Fayad reference is NOT actually prior art against the present application. It is emphasized that the entry of a 37 CFR 1.131 affidavit is distinct from a finding of patentability over the same reference. Here, the reference is not prior art.

The patentability of claims 1-8 and 11-26 lies in each claim as a whole. A single particular element or feature of a claim does not define the claim's patentability, but rather, it is the combination of elements and the interconnection therebetween that define the invention. The claims cannot be considered to be limited in scope based on the brief statement by the Examiner. Applicant stands by its position previously set forth in the file history. Applicant does not acquiesce to the Examiner's partial, and incorrect, paraphrasing of the claim elements.

Entry of these remarks is appreciated and Applicant cordially invites the Examiner to respond, should the Examiner disagree in any manner.

Respectfully submitted,



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